REMARKS

Claims 29-30 have been canceled without prejudice or disclaimer. Claims previously numbered as claims 46-50 have been renumbered as claims 43-47. Claims 28, 31-40, 43 and 45-47 have been amended. Claims 48-50 have been added. Support for the amended and added claims appears, e.g., in the claims as originally filed. Claims 28 and 31-50 are pending in the present application.

It is respectfully submitted that the present amendment presents no new issues or new matter and places this case in condition for allowance. Reconsideration of the application in view of the above amendments and the following remarks is requested.

I. Claim Objections

The claims are objected to because claims 42-45 are missing. Applicants have renumbered the claims, thus obviating this objection.

II. The Rejection of Claims 28, 30-32, 34, 36-39, 46 and 49-50 under 35 U.S.C. 112 (Second Paragraph)

Claims 28, 30-32, 34, 36-39, 46 and 49-50 are rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite. This rejection is respectfully traversed. Applicants have amended the claims to address the Examiner's rejections.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 112. Applicants respectfully request reconsideration and withdrawal of the rejection.

III. The Rejection of Claims 28-50 under 35 U.S.C. 103

Claims 28-50 are rejected under 35 U.S.C. 103 as being unpatentable over Laroye (EP 0910620 B1, hereinafter "Laroye") in view of Henrissat & Davies (Current Opinion in Structural Biology, vol. 7, pp. 637-644 (1997), hereinafter "Henrissat"), and further in view of Schulein (Journal of Bacteriology, vol. 57, pp. 71-81 (1997), hereinafter "Schulein") and further in view of Kofod et al. (US Patent No. 6,197,564, hereinafter, "Kofod"), and further in view of Bower et al. (WO 99/31255, hereinafter, "Bower"), further in view of Sandal et al. (WO 97/27292 A1, hereinafter, "Sandal") and further in view of Lund et al. (WO 97/18286, hereinafter "Lund"). The Examiner states that Laroye teaches a process for production of a mash having enhanced filterability comprising preparing a mash in the presence of enzyme and filtering the mash to obtain a wort, wherein the enzyme comprises a xylanase and a composition comprising a mixture of enzymes; that the enzymes that

may be used are cellulases, betaglucanases and other plant cell wall degrading enzymes; that methods of preparing wort with further improved filterability and increased yield are needed; and a process of reducing viscosity of an aqueous solution comprising starch hydrolysate comprising testing a xylanolytic enzyme for its hydrolytic activity. The Examiner acknowledges however that Laroye does not teach xylanase type A, endoglucanase GH-12 or the amount of enzyme in % w/w of the total. The Examiner goes on to state that Henrissat teaches glycoside hydrolases, xylanase type A and endoglucanase GH-12. The Examiner states that Schulein teaches cellulose-degrading enzymes from *H. insolens* which cooperate in the efficient hydrolysis of cellulose and lower the viscosity of solutions. The Examiner further alleges that routine experimentation is widely used by one of ordinary skill in the art to determine optimum or workable ranges of particular parameters such as pH, temperature, and concentration of enzyme or substrate. The Examiner states that Kofod, Bower, Sandal and Lund each teach xylanase or endoglucanase derived from particular organisms. This rejection is respectfully traversed.

It is well settled that the Patent and Trademark Office has the burden to establish a *prima facie* case of obviousness. *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). "In determining whether a case of prima facie obviousness exists, it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification." *In re Lalu*, 223 U.S.P.Q. 1257, 1258 (Fed. Cir. 1984). "The mere fact that the prior art *could* be so modified would not have made the modification obvious unless the prior art *suggested* the desirability of the modification." *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984) (emphasis added). "[T]he examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

As acknowledged by the Examiner, Laroye does not teach the particular enzymes or the amounts of enzymes in % w/w of the total, as required by the claims. Nor do any of Henrissat, Schulein, Kofod, Bower, Sandal and/or Lund cure this deficiency. Importantly, the Examiner's mere identification of references that teach a variety xylanases or endoglucanases, without further, is insufficient. The Examiner has failed to provide any rationale as to why a skilled artisan would select the elements from the cited prior art references for combination in the manner claimed. In short, the PTO's burden of establishing a *prima facie* case of obviousness has not been met. None of the cited references, either alone or in combination, teach or suggest applicants' claims.

For the foregoing reasons, Applicants submit that the claims overcome this rejection under 35 U.S.C. 103. Applicants respectfully request reconsideration and withdrawal of the rejection.

IV. Conclusion

In view of the above, it is respectfully submitted that all claims are in condition for allowance. Early action to that end is respectfully requested. The Examiner is hereby invited to contact the undersigned by telephone if there are any questions concerning this amendment or application.

Respectfully submitted,

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